

REMARKS

Reconsideration of the above-identified application is respectfully requested. Claims 1 and 18 have been amended, and new Claim 21 has been added. Therefore, Claims 1-7, and 15-21 are pending in the present application. Applicants acknowledge with appreciation that Claims 4, 7, 17, and 19 contain allowable subject matter and will be allowable if rewritten in independent form.

Claims 1-3, 5, 6, 15, 16, 18, and 20 were rejected in an October 4, 2001, Office Action (hereinafter "Office Action") under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,464,681, to Luce (hereinafter "Luce"). Applicants respectfully disagree with the prior art rejections, and have amended the independent claims to further point out and distinctly claim the novel aspects of the present invention. The reasons why applicants disagree with the rejections cited in the Office Action and believe that the claims of the present application are allowable are discussed below, following a brief description of the invention in a brief description of the cited prior art.

Applicants Invention

The present invention is directed toward a printed document, such as a bank note, having a counterfeiting prevention feature. The document includes a substrate, which can be a polymer film or paper, having a surface to which printed matter is applied. The document also includes a reflective or brightly coloured layer applied to the surface of the substrate by a printing process. The reflective or brightly coloured layer can be ink, which produces a reflective or brightly coloured effect, or a reflective foil, typically comprising a carrier film, a release layer, a metallized layer, and an adhesive. After the reflective or brightly coloured layer is applied, printed matter is then applied to the surface of the reflective or brightly coloured layer by the Intaglio process to produce a print having raised regions. The raised regions of the printed

matter form an image, which is significantly enhanced by the reflective or brightly coloured background when viewed under different lighting conditions and viewing angles. When a polymer substrate is used, the smooth surface of the polymer substrate further intensifies the reflective effect of the reflective or brightly coloured layer.

Luce

Luce is directed toward a replaceable adhesive display. Generally described, Luce addresses the need for providing a paper or foil display coated with a replaceable adhesive that leaves substantially no mark from the adherand surface and can be attached or mounted repeatedly to a surface. Luce purportedly discloses a replaceable adhesive display composed of a paper substrate or a metallized paper or foil to which an image is printed on at least one side. A transparent plastic overlay is applied on both sides of the printed paper substrate, which may protect the printed image from smudges, abrasion, fading, and the like. A replaceable adhesive is disposed on the side of the paper substrate opposite the print side for mounting to a surface.

Luce states that an object of the replaceable adhesive display is to utilize a paper or metallized paper substrate to overcome the deficiencies of prior art displays that utilize a plastic substrate. Accordingly, Luce does not disclose and in fact teaches away from the use of a plastic substrate for the replaceable adhesive display.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-3, 5, 6, 15, 16, 18, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Luce. The Office Action states that Luce discloses a printed matter having a metallized paper substrate with an image printed on one or both sides of the substrate. A metallized paper provides a reflective appearance. However, the Office Action states that Luce does not disclose a plastic substrate to which a reflective or brightly colored layer is applied. Although Luce does not disclose the use of a plastic substrate, the Examiner takes official notice

that the use of plastic substrates is well known, and would therefore be obvious to one of ordinary skill in the art at the time of Applicants' invention.

Applicants agree with the Office Action that Luce does not teach a plastic substrate on which a reflective or brightly colored layer is applied. However, Applicants respectfully submit there is no suggestion or motivation to substitute the paper or metallized paper of Luce with a plastic substrate to arrive at the claimed combination recited in Claims 1 and 18. Additionally, Applicants respectfully submit that Luce fails to teach or suggest a reflective or brightly coloured layer being applied by a printing process directly onto a plastic substrate, as recited in Claim 1. Therefore, Applicants respectfully traverse the rejection of these claims.

Independent Claim 1

As amended, independent Claim 1 recites a printed document that includes "a substrate of plastics film . . . having a surface to which printed matter is applied, a reflective or brightly coloured layer applied directly to said surface as part of a printing process, and a raised printed image applied to said reflective or brightly coloured layer by a printing process." The present invention, as defined by Claim 1, provides a printed document composed of a plastic substrate, a reflective or brightly coloured layer applied to the plastic substrate, and a raised printed image applied to the reflective or brightly coloured layer. By applying a raised printed image on a reflective or brightly coloured layer, the colour of the printed image is intensified and becomes brighter, and thus is enhanced. When using a substrate made of plastic, the surface of the plastic substrate intensifies the reflective effect produced by the reflective or brightly coloured layer. As will be discussed in detail below, Applicants respectfully submit there is no suggestion or motivation to substitute the paper or metallized paper of Luce with a plastic substrate to arrive at Applicants' invention as defined in Claim 1.

Luce is directed to a replaceable adhesive display. As described above, Luce purportedly teaches a replaceable adhesive display composed of a paper substrate or a metallized paper or foil to which an image is printed on at least one side. A transparent plastic overlay is applied on both sides of the printed paper substrate, which may protect the printed image from smudges, abrasion, fading, and the like. A replaceable adhesive is disposed on the side of the paper substrate opposite the print side for mounting to a surface. In previous displays described in Luce's background of the invention, a plastic substrate was used in constructing the display. However, the use of plastic substrates in such displays "require a relatively strong bonding adhesive, and when the display is removed from its mount, an adhesive residue or mark off is noticeable, which typically needs to be scraped off of the mounting surface. Further, if the adhesive is applied to the print side, or if both sides of the substrate are printed, a strong adhesive may pull away some of the ink, leaving it, along with the adhesive residue, on the mounting surface." See Column 1, line 62, through Column 2, line 5. The intended purpose of Luce is to address these deficiencies in the prior art by utilizing a paper substrate because of the advantages associated with paper substrates. These advantages include significant cost savings in that paper is substantially cheaper than plastic substrate materials, normally does not require special inks, and exhibits better ink holdout. See Column 2, lines 24-31. Additionally, a paper substrate presents a clearer, sharper, and more aesthetically pleasing image than plastic substrates. See Column 2, lines 31-33.

Since Luce explicitly states that the intended purpose of the invention is to provide a paper or foil display coated with a replaceable adhesive that overcomes the deficiencies of plastic substrates noted in the prior art, Applicants submit that one of ordinary skill in the art would not modify Luce by looking to the purportedly well know teachings in the art for the use of a plastic substrate. Further, Applicants submit that modifying Luce to include a plastic substrate defeats

the intended purpose of Luce, that is, to provide a display which is coated with a replaceable adhesive that leaves no marks or residue and can be attached or mounted repeatedly to a surface.

As a general rule, obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d (1596 Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992). Moreover, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. See MPEP 2143.01. Applicants respectfully assert that the Office Action's suggestion to substitute a plastic substrate purportedly well known in the art for the paper or metallized paper substrate of Luce to arrive at Applicants' claimed combination is hindsight and would destroy the intended purpose of Luce. Therefore, for at least these reasons, Applicants submit that a *prima facie* case of obviousness has not been established. Thus, Applicants respectfully request the pending rejection of Claim 1 under 35 U.S.C. § 103(a) be withdrawn. Accordingly, Applicants respectfully request that the Examiner also withdraw the pending rejections to Claims 2, 3, 5, 6, 15, and 16, which depend from allowable Claim 1.

Even if there existed a suggestion or motivation to substitute a plastic substrate purportedly well known in the art for the paper or metallized paper substrate of Luce, which Applicants specifically deny, Applicants further submit that Luce fails to teach or suggest all of the elements recited in Claim 1. Specifically, Applicants submit that Luce fails to teach "a reflective or brightly coloured layer applied directly to said surface as part of a printing process."

Luce purportedly teaches a replaceable adhesive display composed of a paper substrate or a metallized paper or foil to which an image is printed on at least one side. A transparent plastic

overlay is applied on both sides of the printed paper substrate, which may protect the printed image from smudges, abrasion, fading, and the like. A replaceable adhesive is disposed on the side of the paper substrate opposite the print side for mounting to a surface. However, Luce does not disclose how the metallized layer of the metallized paper or foil is applied to the paper substrate. Therefore, Applicants submit that Luce fails to disclose that the metallized layer of the metallized paper or foil is applied by a printing process.

The cited and applied reference simply does not teach or suggest a printed document having a substrate of plastics film having a surface to which printed matter is applied, and a reflective or brightly coloured layer applied directly to the surface as part of a printing process. Under 35 U.S.C. § 103(a), a *prima facie* case of obviousness is established only if the cited references teach or suggest each of the limitations of a recited claim. *In re Bell*, 991 F.2d 781 (Fed. Cir. 1993). Because Luce fails to teach or suggest each of the elements of Claim 1, Applicants respectfully submit a *prima facie* case of obviousness has not been established. Therefore, Applicants respectfully request the withdrawal of the pending rejection under 35 U.S.C. § 103(a) with regard to Claim 1. Accordingly, Applicants respectfully request that the Examiner also withdraw the pending rejections to Claims 2, 3, 5, 6, 15, and 16, which depend from allowable Claim 1.

Independent Claim 18

For the same reasons as discussed above with respect to Claim 1 regarding the substitution of a plastic substrate, Applicants invention, as recited in Claim 18, is not rendered obvious over the teachings of Luce. Claim 18 recites a printed document including "a plastic substrate having a surface to which printed matter is applied; a reflective or brightly coloured layer affixed directly to said surface of said plastic substrate; and a print layer forming an image, said print layer affixed to said reflective or brightly coloured layer." Applicants respectfully



submit that Luce, either alone or in combination, fails to teach or suggest the plastic substrate recited in Claim 18. Moreover, Applicants further submit that one skilled in the art would not be able to properly combine Luce with the purportedly well known plastic substrate as suggested in the Office Action. For at least these reasons, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. Thus, Applicants respectfully request the withdrawal of the pending rejection under 35 U.S.C. § 103(a) with regard to Claim 18. Accordingly, Applicants respectfully request that the Examiner also withdraw the pending rejection to Claim 20, which depends from allowable Claim 18.

New Claim 21

Claim 19, which was deemed to contain allowable subject matter in the Office Action, has been rewritten as new Claim 21. Accordingly, Applicants respectfully submit that new Claim 21 is allowable over the prior art.

CONCLUSION

In conclusion, Applicants submit that the claims of the present application are allowable over the cited and applied references. If any further questions remain, the Examiner is invited to telephone Applicants' attorney at the number listed below.

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Respectfully submitted,
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}

Brandon C. Stallman
Registration No. 46,468
Direct Dial No. 206.695.1708

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Patents, Washington, D.C. 20231, on the below date.

Date: January 4, 2002
BCS:cg

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

VERSION WITH MARKINGS TO SHOW CHANGES MADE JANUARY 4, 2002

In the Claims:

1. (Amended) A printed document or other device comprising a substrate of plastics film capable of use to form a bank note and having a surface to which printed matter is applied, a reflective or brightly coloured layer applied directly to said surface as part of a printing process [without embossing the layer], and a raised printed image applied to said reflective or brightly coloured layer by a printing process, at least part of said raised printed image having a height of at least 5µm, [and being visible from all angles of the document, said raised printed image being enhanced by] said reflective or brightly coloured layer being printed directly on the substrate to utilize any reflective effect in the plastics film to intensify the reflective properties of the reflective or brightly coloured layer and to further enhance the raised printed image when viewed at different angles and under different lighting conditions.

18. (Amended) A printed document comprising:

a plastic substrate having a surface to which printed matter is applied;

a reflective or brightly coloured layer affixed directly to said surface of said plastic substrate; and

a print layer forming an image, said print layer affixed to said reflective or brightly coloured layer.

Claim 21 has been added.



1774
BOX NON-FEE
AMENDMENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: R.G. Gration et al. Attorney Docket No.: CASM114222
Application No.: 09/355,169 Group Art Unit: 1774
Filed: October 30, 1999 Examiner: B. Shewareged
Title: PRINTED MATTER PRODUCING REFLECTIVE INTAGLIO EFFECT

AMENDMENT TRANSMITTAL LETTER

Seattle, Washington 98101

January 4, 2002

TO THE COMMISSIONER FOR PATENTS:

A. Amendment Transmittal

Transmitted herewith is an amendment in the above-identified application.

X 1. No additional claim fee is required, as shown below.

COMPUTATION OF FEE FOR CLAIMS AS AMENDED

| | Claims Remaining After Amendment | | Highest Number Previously Paid For | | Present Extra | | Rate | | Additional Fee |
|--------------------|---|---|---|---|------------------|---|------|---|-------------------|
| Total Claims | 17 | - | 20 | = | 0 | x | 18 | = | 0 |
| Independent Claims | 3 | - | 3 | = | 0 | x | 84 | = | 0 |
| TOTAL | | | | | | | | | \$0 |

B. Additional Fee Charges or Credit for Overpayment

The Commissioner is hereby authorized to charge any fees under 37 C.F.R. §§ 1.16, 1.17 and 1.18 which may be required during the entire pendency of the application, or credit any overpayment, to Deposit Account No. 03-1740. This authorization also hereby includes a

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{LLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100



request for any extensions of time of the appropriate length required upon the filing of any reply during the entire prosecution of this application.

Respectfully submitted,
CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}

Brandon C. Stallman
Direct Dial No. 206.695.1708
E-Mail Address: stallmb@cojk.com

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Patents, Washington, D.C. 20231, on the below date.

Date: January 4, 2002

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CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100